

REMARKS

Claims 1 – 19 and 24 – 40 are pending and rejected. The Examiner withdraws his rejection of claims 1 – 19 over U.S. Patent 6,258,200 issued to Kassab but maintains his rejections of claims 24 – 40 over Kassab. In addition, the Examiner rejects claims 1 – 2, 4 – 11, 13, 16 – 19, 24 – 30 and 33 – 41 under 35 U.S.C. §102(b) over U.S. Patent 5,403,025 issued to Shanley (Shanley). Furthermore, the Examiner rejects claims 1 – 19 and 24 – 41 under 35 U.S.C. §103(a) over Shanley and U.S. Patent 5,334,431 issued to Longtin (Longtin).

The applicants thank the Examiner for withdrawing his rejection of claims 1 – 19 over Kassab. The applicants amend claims 1, 24, 25, 36, 40 and 41. The applicants respectfully disagree with the Examiner's rejections of the claims 1 – 19 and 24 – 40 and believe the claims, as amended, are in condition for allowance for the reasons discussed below.

Claim Rejections Under 35 U.S.C. §102(e) Over Kassab

Claim 1 claims a plurality of mounts, claims 24 and 25 claim a single mount. The single mount defined in claims 24 and 25 has all of the features of each mount in the plurality of mounts that are defined in claim 1. Claim 24 further defines that the mount is capable of adhering only to a part of one surface of a sheet of paper. Claim 25 further defines that the mount is capable of releasably adhering the mount to a sheet of paper. Claims 36 and 40 are in the format of use claims. The definition of the mount in claims 36 and 40 correspond to the definition of the mount in claims 25 and 24 respectively.

Rejection of Claim 24

The applicants respectfully disagree with the Examiner's rejection of claim 24. The applicants maintain their assertion that Kassab does not directly and unambiguously disclose a mount comprising a body made of a single material and having a first surface carrying an adhesive coating capable of adhering the mount to a sheet of paper.

Firstly, the passage at column 3 lines 56 to 58 referred to by the Examiner does not directly and unambiguously disclose the adhesive being provided on the mount surface prior to the sticker being adhered to it. The adhesive layer is described in relation to the substrate and not in relation to the static-cling film. It is said in the subsequent sentence that the static-cling assembly is then adhered to the receiving surface by placing the second side of the static-cling film against the receiving surface (i.e. after the adhesive layer is applied to the substrate). In fact, the application of the adhesive layer to the indicia bearing surface as a separate step is described explicitly in column 8 lines 43 to 45.

Secondly, claim 24, as amended, now excludes the presence of additional layers in the mount assembly. We understand that the Examiner was arguing in the Office Action that the combined static-cling film and sticker in Kassab would anticipate a mount comprising a body having a first surface carrying an adhesive coating capable of adhering the mount to a sheet of paper. It is submitted that this argument now is unfounded. Firstly, if we are to take the combined static-cling film and sticker assembly as the “mount” clearly, it is not possible to define a body made from a single material having a first surface carrying an adhesive coating in this arrangement. The combined assembly is not made from a single material and none of the surfaces of the combined assembly carries an adhesive coating. The word “surface” clearly means the exterior part of something. In the combined static-cling film and sticker assembly, the adhesive layer would form a part of the interior structure.

Conversely, if the Examiner considers that only the “static-cling film plus adhesive” part of the combined static-cling film and sticker assembly is to be defined as the “mount” it is submitted that this so-called mount cannot be isolated from the sticker since we are told in column 6 lines 15 to 28 for example that attempts to separate the static-cling film from the sticker would likely destroy the film and the sticker. Further, column 9, line 64 to column 10, line 4 specifically states that there is no ability to separate the sticker from the film. Therefore, in the static-cling film and sticker assembly described in Kassab, it is not possible to define an isolated mount with surfaces according to claim 24.

Therefore, applicants assert that Kassab fails to anticipate claim 24.

Rejection of Claims 25 – 29 and 33

Claim 25, as amended, is patentable over Kassab for reasons similar to those recited in support of claim 24, as amended, over Kassab under 35 U.S.C. §102(e).

Furthermore, claim 25 recites that the mount is capable of releasably adhering to a sheet of paper. As already mentioned above, column 6 of Kassab clearly teaches completely away from this since, in Kassab, once the sticker is adhered to the static-cling film, it remains adhered.

Claims 26 – 29 and 33 are patentable by virtue of their dependencies from claim 25.

Rejection of Claims 36 – 39

Claim 36, as amended, is patentable over Kassab for reasons similar to those recited in support of claim 25, as amended, over Kassab under 35 U.S.C. §102(e).

Claims 37 – 39 are patentable by virtue of their dependencies from claim 36.

Rejection of Claim 40

Claim 40, as amended, is patentable over Kassab for reasons similar to those recited in support of claim 24, as amended, over Kassab under 35 U.S.C. §102(e).

Claim Rejections Under 35 U.S.C. §103(a) Over Kassab

Rejection of Claim 24

The applicants respectfully disagree with the Examiner's rejection of claim 24. Kassab neither teaches nor suggests the provision of a self-adhesive tool (a mount) for

adhering plain paper to glass without further application of adhesive to the paper or to the film. Kassab is concerned solely with placing a self-adhesive sticker on a windshield. In this regard, Kassab is concerned particularly with the problem of transferring a self-adhesive sticker from one car windshield to another. The solution provided by Kassab is to not stick the sticker straight to the windscreen but rather to first stick the sticker permanently onto a static-cling film and using the peelable nature of the film to releasably attach the arrangement to the windscreen.

This is different than the present application. The present application is not concerned with the problem of placing a self-adhesive sticker on a windshield. In contrast to this, the present invention is concerned with a preformed, ready-for-use tool for mounting ordinary paper to a substrate such as glass without the need for the separate application of an adhesive. In the present invention, the mount *per se* is provided with an adhesive layer on one surface. This is neither taught nor rendered obvious by the teaching of Kassab which teaches only that the static-cling film is useable in combination with a substrate having an adhesive layer (either integral with the substrate or applied separately). In Kassab, if the static-cling film is to be used with a substrate without an integral adhesive layer, the solution provided by Kassab is to separately apply an adhesive layer to the substrate. The present invention clearly provides a definite improvement over this solution in the form of a read-for-use mount where the need for a step of separately applying an adhesive is omitted.

Therefore, the applicants assert that Kassab fails to make claim 24 obvious.

Rejection of Claims 25 – 35

Claim 25 is patentable over Kassab for reasons similar to those recited in support of claim 24 over Kassab under 35 U.S.C. §103(a).

Furthermore, with particular reference to claim 25, as mentioned above, this claim explicitly recites that the mount is capable of releasably adhering to a sheet of paper. This is completely against the teaching of Kassab, which requires that once the sticker is adhered to the static-cling film, it remains adhered.

Claims 26 – 35 are patentable by virtue of their dependencies from claim 25.

Rejection of Claims 36 – 39

Claim 36 is patentable over Kassab for reasons similar to those recited in support of claim 25 over Kassab under 35 U.S.C. §103(a).

Claims 37 – 39 are patentable by virtue of their dependencies from claim 36.

Rejection of Claim 40

Claim 40 is patentable over Kassab for reasons similar to those recited in support of claim 24 over Kassab under 35 U.S.C. §103(a).

Claim Rejections Under 35 U.S.C. §102(b) Over Shanley

Rejection of Claims 1 – 2, 4 – 11, 13 and 16 – 19

Applicants respectfully disagree with the examiner's rejection of claim 1. The Examiner asserts that claim 1 is anticipated by Shanley. In view of the Examiner's assertion, the applicants amend claim 1 in order to specify that the mount is made of a single material. Support for this amendment may be found throughout the specification including from page 5 first full paragraph, page 6 second to last line, page 7 line 3, the whole of page 8 and page 11 second full paragraph.

Referring to Shanley, this document describes an arrangement whereby a layer of vinyl static cling material is laminated on top of a layer of polyester material, where the layer of polyester material has an adhesive coating applied on its side, opposite to its side which has received the vinyl static ling material lamination. The layer of vinyl static cling material does not carry an adhesive coating. Furthermore, since polyester *per se* does not have the static cling properties that would enable it to adhere a sheet of paper to glass, it is understood that the Examiner considers that it is the complete

vinyl/polyester/adhesive arrangement that anticipates the present claims. In view of this, in order to overcome the Examiner's rejection, claim 1 has been amended to specify that each mount is made of a single material. Therefore, the arrangement of Shanley whereby the "mount" includes a vinyl static cling layer and a polyester layer is excluded.

Claims 2, 4 – 11, 13 and 16 – 19 are patentable by virtue of their dependencies from claim 1.

Rejection of Claim 24

Claim 24, as amended, is patentable over Shanley for reasons similar to those recited in support of claim 1, as amended, over Shanley under 35 U.S.C. §102(b).

Rejection of Claims 25 – 30 and 33 – 35

Claim 25, as amended, is patentable over Shanley for reasons similar to those recited in support of claim 1, as amended, over Shanley under 35 U.S.C. §102(b).

Claims 26 – 30 and 33 – 35 are patentable by virtue of their dependencies from claim 25.

Rejection of Claims 36 – 39

Claim 36, as amended, is patentable over Shanley for reasons similar to those recited in support of claim 1, as amended, over Shanley under 35 U.S.C. §102(b).

Claims 37 – 39 are patentable by virtue of their dependencies from claim 36.

Rejection of Claim 40

Claim 40, as amended, is patentable over Shanley for reasons similar to those recited in support of claim 1, as amended, over Shanley under 35 U.S.C. §102(b).

Rejection of Claim 41

Claim 41, as amended, is patentable over Shanley for reasons similar to those recited in support of claim 1, as amended, over Shanley under 35 U.S.C. §102(b).

Claim Rejections Under 35 U.S.C. §103(a) Over Shanley and Longtin

Rejection of Claims 1 – 19

Applicants respectfully disagree with the Examiner's rejection of claim 1 over Shanley and Longtin under 35 U.S.C. §103(a). Having established novelty for claim 1 over Shanley, it is submitted that claim 1 is not obvious over Shanley and Longtin. This is because, in Shanley, the two-layer arrangement is essential in order for the arrangement to be able to be used as described. In Shanley, it is essential that the vinyl layer and the polyester layer can be separated from each other during the utilization process since one is used as an information label on the windshield of a vehicle and the other is used as a label on an invoice record form (column 2 line 48 to 67). A mount according to the present invention that is made from a single material would be wholly unsuitable for the use described in Shanley. In summary, the labels in Shanley would be incapable of performing the function of a mount according to the present invention and moreover the labels in Shanley do not seek to perform this function. Therefore, it cannot be reasonably said that the mount according to the present invention would be obvious in view of Shanley.

With regard to the disclosure of Longtin, we understand that the Examiner cited this document as evidence that the mount assembly being in the form of a sheet is functionally equivalent to the mount assembly being in the form of a roll. In the present case, however, we are not arguing that using a sheet form instead of a roll form is part of the present invention.

As a further point, it is important to note that neither Shanley nor Longtin in fact is concerned with the same technical field as the present invention. These documents

both are concerned with labels and with a method for the safe deliver of these labels thus preserving its cling quality. These documents are not concerned at all with a new tool (namely a mount) for attaching a first material such as paper to a second material such as glass.

Claims 2 – 19 are patentable by virtue of their dependencies from claim 1.

Rejection of Claim 24

Claim 24, as amended, is patentable over Shanely and Longtin for reasons similar to those recited in support of claim 1, as amended, over Shanely and Longtin under 35 U.S.C. §103(a).

Rejection of Claims 25 – 35

Claim 25, as amended, is patentable over Shanely and Longtin for reasons similar to those recited in support of claim 1, as amended, over Shanely and Longtin under 35 U.S.C. §103(a).

Claims 26 – 35 are patentable by virtue of their dependencies from claim 25.

Rejection of Claims 36 – 39

Claim 36, as amended, is patentable over Shanely and Longtin for reasons similar to those recited in support of claim 1, as amended, over Shanely and Longtin under 35 U.S.C. §103(a).

Claims 37 – 39 are patentable by virtue of their dependencies from claim 36.

Rejection of Claim 40

Claim 40, as amended, is patentable over Shanely and Longtin for reasons similar to those recited in support of claim 1, as amended, over Shanely and Longtin under 35 U.S.C. §103(a).

Rejection of Claim 41

Claim 41, as amended, is patentable over Shanely and Longtin for reasons similar to those recited in support of claim 1, as amended, over Shanely and Longtin under 35 U.S.C. §103(a).

Conclusion

Applicants respectfully request the Examiner withdraw his rejection of claims 1 – 19 and 24 – 41 in view of applicants' amendments and remarks and issue an allowance for these claims.

Applicants have enclosed a check (No. 21495) to pay for a two-month extension of time. Should any additional fees be required please charge them to Deposit Account No. 07-1897.

If the Examiner believes that a phone interview would be helpful, he is respectfully requested to contact the Applicants' attorney, John Janeway, at (425) 455-5575.

DATED this 23rd day of December 2003.

Respectfully submitted,
GRAYBEAL JACKSON HALEY LLP



John M. Janeway
Attorney for Applicant
Registration No. 45,796
155-108th Avenue N.E., Ste. 350
Bellevue, WA 98004-5973
(425) 455-5575